ESTTA Tracking number:

ESTTA1088473

Filing date:

10/13/2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	John Zox
Granted to Date of previous extension	10/11/2020
Address	CHURCH ST. STA PO BOX 3236 NEW YORK, NY 10008 UNITED STATES

information DARREN M. GELIEBTER LOMBARD & GELIEBTER LLP 230 PARK AVENUE, 4TH FLOOR WEST NEW YORK, NY 10169 UNITED STATES Primary Email: dgeliebter@lgtrademark.com Secondary Email(s): ehuang@lgtrademark.com, ipdocket@lombardip.com 212-520-1172	Correspondence information	230 PARK AVENUE, 4TH FLOOR WEST NEW YORK, NY 10169 UNITED STATES Primary Email: dgeliebter@lgtrademark.com Secondary Email(s): ehuang@lgtrademark.com, ipdocket@lombardip.com
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Applicant Information

Application No.	88582432	Publication date	04/14/2020
Opposition Filing Date	10/13/2020	Opposition Peri- od Ends	10/11/2020
Applicant	ZOX LLC 23823 MALIBU RD. #50-408 MALIBU, CA 90265 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2012/11/27 First Use In Commerce: 2012/11/27

All goods and services in the class are opposed, namely: Provision of an on-line marketplace forbuyers and sellers of wristbands and bracelets

Grounds for Opposition

No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Related Proceed-	92074323
ings	

Attachments	2020-10-13 Notice of Opposition to ZOXLIST w Exhibit - FINAL.pdf(786497 bytes)

Signature	/Darren M. Geliebter/
Name	DARREN M. GELIEBTER
Date	10/13/2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JOHN ZOX,		
	Opposer,	Opposition No
v. ZOX LLC,		Application Serial No. 88/582,432
,	Applicant.	Mark: ZOXLIST

NOTICE OF OPPOSITION

Opposer John Zox, an individual residing in New York, New York, believes that he is and will continue to be damaged by the registration of Applicant ZOX LLC's ("Opposer")

Application Serial No. 88/582,432 for **ZOXLIST** (the "'432 Application") and hereby opposes the same on the basis of Applicant's prosecution of a registration in the U.S. Patent & Trademark Office for Applicant's mark by a false or fraudulent declaration or representation in writing, and non-use or discontinuance of use of Applicant's mark and intent not to resume or begin such use.

The grounds for opposition of Applicant's **ZOXLIST** mark is as follows:

FACTS

Opposer and His ZOX Marks

1. Opposer is a member of the nationally recognized Providence, Rhode Island-based indie band ZOX which was founded in 1998. Since 2001, ZOX has released three full length albums, four EP albums, and eight singles, and has been featured on Billboard's top charts. ZOX toured throughout the United States and worldwide full time between 1998 and 2009, performing between 200 and 300 shows per year. ZOX has opened for or toured with

bands such as The Black Eyed Peas, O.A.R., Rusted Root, Common, Ok Go, The Roots, Everclear, Dispatch, Live, Guster, and more. ZOX has been a featured artist at South by Southwest music festival in Austin, Texas, and has toured on the Warped Tour, the largest traveling music festival in the United States. Other festivals ZOX performed at include the UK's Reading and Leeds Festivals, Germany's Rock am Ring and Rock im Park Festivals, Italy's Rock the Week, NovaRock Austria, and Switzerland's Greenfield Festival. In 2006, the band signed with SideOneDummy Records (The Mighty Mighty Bosstones, Gogol Bordello, Flogging Molly) in 2006, Foundations Artist Management (Dr. Dog, Dispatch, Owl City), CAA Booking Agency (AC/DC, John Mayer, etc.), and Dave Stein/Jennifer Justice of Carroll, Guido & Groffman, LLP (Jay-Z). ZOX music has been and continues to be featured and synced worldwide in all media, including on television, e.g., MTV's *The Real Word/Road Rules* and *Project Runway*, in film, e.g., *Snow Gods*, and in video, including dozens of music videos on YouTube.

- 2. From 2009 to present, ZOX performed occasional shows each year through the Northeastern United Sates, with the last show in 2014. ZOX has and currently intends to play reunion shows and small tours and create new music for the rest of the bandmembers' lives. ZOX's next show is in December 2020.
- 3. Throughout its existence, ZOX has sold a wide variety of merchandise, both at shows and online, primarily including apparel, band paraphernalia, CDs, and print posters. On tours, ZOX also sold various merchandise including shoelaces, headbands, shot glasses, bumper stickers, games, wristbands, gift cards, etc.
- 4. ZOX markets, promotes, and sells its merchandise online at its website www.zoxband.com and www.zoxband.com and at shows.
 - 5. ZOX's music has been widely streamed online on platforms since 1998, including

more recently on Pandora, Amazon, Apple, and Spotify, generating income from over 1 million streams annually.

6. Opposer—either individually, as co-applicant with his brothers Andrew Zox and Daniel Zox, or in partnership with fellow ZOX band member Eli Miller under the partnership name Zox Music—owns in whole or in part the right, title and interest in and to the **ZOX** Marks, the applications and registrations for which are indicated below:

MARK and	REG. NO.	GOODS	CLASS	FIRST	FILING	REG.
OWNERS				USE	DATE	DATE
ZOX	Ser. No.	Non-magnetically encoded gift	16	Sept. 1,	Dec. 13,	Pending
(John Zox)	88228839	cards; Stickers and transfers		2004	2018	
		Non-metal identification bracelets	20	June 1,		
				2005		
		All-purpose straps comprised of	22	June 1,		
		synthetic textile materials; Sacks or		2005		
		bags for the transportation or storage				
		of materials in bulk; String.				
		Fabrics for textile use.	24	Jan. 1,		
				2007		
		Arm bands; Belt buckles; Charms for	26	June 1,		
		shoes; Clothing accessories, namely,		2005		
		charms for attachment to zipper pulls				
		and buttons; Hair bands; Shoe laces.				
		Party games	28	Jan. 1,		
				2007		
ZOX	Ser. No.	Prerecorded video cassette tapes,	9	Jan. 1,	Mar. 28,	Aug. 22,
(Andrew Zox,	86954997	audio and video discs in the nature of		2006	2016	2017
Daniel Zox,		CDs and DVDs and digital files,				
John Zox)	Reg. No.	motion picture and documentary				
	5268843	film, all featuring live action,				
		computer generated, animated				
		cartoons and musical entertainment				
		and educational subject matter in the				
		field of literature, science, history,				
		art, government, engineering,				
		philosophy, fashion, mathematics,				
		economics, and zoology; film and				
		video equipment, namely still,				
		motion picture film and video				
		cameras, videocassette recorders,				
		videocassette players, digital video				
		or audio players, and film and video				
		editing machines; computer software				
		for film and video editing; eyeglasses				
		Production, development and	41	Jan. 1,		
		distribution of motion picture films,		2006		
		television programs, documentary				

		films, music videos, virtual and				
		augmented reality videos, concert				
		video and interactive media in the				
		nature of literature, science,				
		technology, religion, sports, politics,				
		history, art, government,				
		engineering, philosophy, fashion,				
		mathematics, and economics;				
		theatrical or musical works				
		performed in a live setting;				
		publication of books and				
		1 *				
		screenplays; providing a website				
		featuring educational information in				
		the field of music, theater, cinema,				
		design, photography, visual and				
		performing arts and animal training;				
		production of audio and audiovisual				
		recordings; Entertainment in the				
		nature of live radio personality				
		performances; Entertainment				
		services, namely, providing webcasts				
		and video podcasts in the field of				
707	G 31	personality performances.	0	3.5 2.0		2.5
ZOX	Ser. No.	Compact discs featuring musical	9	May 30,	Apr. 1,	May 4,
(Zox Music	78232386	sound recordings		2000	2003	2004
Partnership of	D 37					G 11 1
Eli D. Miller	Reg. No.					Cancelled
and John Zox)	2838652					Dec. 10,
			4.1	1 20		2010
		Entertainment, namely, live	41	Jan. 29,		
70V (1.1.)	G 11	performances by a musical band	0	1999		
ZOX (design)	Ser. No.	Series of compact discs featuring	9	May 30,	June 3,	July 5,
(ZOX)	78429680	musical sound recordings		2000	2004	2005
	D 31					
(Zav Music	Reg. No.					Cancelled
(Zox Music Partnership of	2965344					Oct. 12,
Eli D. Miller						2012
and John Zox)						
anu Juni Zux)		Entartainment namely live	41	Nov. 28,		
		Entertainment, namely, live	41	,		
		performances by a musical band	l	1999		

- 7. A true and correct copy of the trademark registrations are attached hereto as **Exhibit A**. Each of the registrations (except as indicated) shown in Exhibit A are valid and subsisting, and are *prima facie* or conclusive evidence of Opposer's exclusive right to use said marks in commerce on the goods and services specified in each registration.
 - 8. Opposer is also the owner of common law rights to the same marks identified in

Paragraph 6 dating back to at least as early as 1999.

9. On May 26, 2020, Applicant filed a petition to cancel Opposer's United States Trademark Registration No. 5,268,843 registered on August 22, 2017 to Opposer John Zox, Daniel Zox, and Andrew Zox, for **ZOX**, in Cancellation Proceeding No. 92074323. As basis for cancellation, Applicant asserted the subject application of this Opposition, Application Serial No. 88/582,432 for **ZOXLIST**.

Applicant and Its ZOXLIST Mark

- 10. On information and belief, Applicant ZOX LLC is a California limited liability company having offices at 5304 Derry Avenue Suite G, Agoura Hills, California 91301.
- 11. Applicant is the listed owner for the '432 Application for **ZOXLIST** for "Provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35.

NON-USE

- 12. On information and belief, Applicant has not used, nor has it ever used to this day, the **ZOXLIST** mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.
- 13. On information and belief, as of November 27, 2012, Applicant's claimed date of first use in commerce, Applicant was not using the mark **ZOXLIST** in connection with the sale or advertising of "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate, as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.
- 14. On information and belief, as of August 16, 2019, Applicant's filing date for the '432 Application, Applicant was not using the mark **ZOXLIST** in connection with the sale or

advertising of "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate, as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.

- 15. Applicant's acts as complained of herein, namely non-use of the mark **ZOXLIST** and intent not to begin such use in connection with "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate, constitutes non-use of the mark **ZOXLIST** pursuant to 15 U.S.C. § 1127, which mandates refusal of the '432 Application because Applicant is not entitled to registration of its trademark.
- 16. Applicant has therefore never used the '432 Application for **ZOXLIST** with respect to all goods and services, and the registration should be refused and denied because Applicant is not entitled to registration of its trademark.

ABANDONMENT

- 17. On information and belief, Applicant has discontinued use of the **ZOXLIST** mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127 for at least three consecutive years, and has no intention of resuming use of the mark.
- 18. On information and belief, for some period of time between November 27, 2012, Applicant's claimed date of first use in commerce, and the present, Applicant discontinued using the mark **ZOXLIST** in connection with the sale or advertising of "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate, as required by Section 45 of the Trademark Act, 15 U.S.C. §1127, and had no intention of resuming use of the mark.
 - 19. Applicant's acts as complained of herein, namely discontinuance of use of the

mark **ZOXLIST** and intent not to resume or begin such use in connection with "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in interstate, international, or other commerce which Congress may regulate, constitutes abandonment of the mark **ZOXLIST** pursuant to 15 U.S.C. § 1127, which mandates refusal of the '432 Application.

20. Applicant has therefore abandoned the '432 Application for **ZOXLIST** with respect to all goods and services, and registration should be refused and denied.

FRAUD ON THE U.S. PATENT AND TRADEMARK OFFICE

- 21. On August 16, 2019, Applicant filed the '432 Application for the mark **ZOXLIST**, which included a sworn declaration signed under penalty of perjury by Kara Kuipers, counsel for Applicant, that the mark **ZOXLIST** was "first used in commerce at least as early as 11/27/2012, and is now in use in such commerce" in International Class 35.
- 22. On information and belief, as of November 27, 2012, and up to this very day, Applicant was not using the **ZOXLIST** mark in connection with the sale or advertising of "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate.
- 23. On information and belief, Applicant knew that its statements regarding use of the **ZOXLIST** mark in commerce were false at the time such statements were made.
- 24. On information and belief, Applicant has never used the **ZOXLIST** mark in connection with the sale or advertising of "provision of an on-line marketplace for buyers and sellers of wristbands and bracelets" in International Class 35 in interstate, international, or other commerce which Congress may regulate.
 - 25. When Applicant submitted the specimen and provided the dates of first use in its

application to register on August 16, 2019, it knew, or should have known, that it had never used the **ZOXLIST** mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. \$1127.

- 26. When Applicant submitted the signed declaration along with its application to register the **ZOXLIST** mark on August 16, 2019, it knew, or should have known, that it could not have been using the mark in commerce as required by Section 45 of the Trademark Act, 15 U.S.C. §1127.
- 27. When Applicant submitted the specimen and provided the dates of first use in interstate commerce on August 16, 2019, it knowingly submitted false and/or fraudulent information to the U.S. Patent & Trademark Office and/or knowingly made false and/or fraudulent representations to the U.S. Patent & Trademark Office.
- 28. Accordingly, Applicant's sworn statement on August 16, 2019 that it was using the mark in commerce directly or through a related company was false and/or fraudulent.
- 29. Inasmuch as Applicant submitted on August 16, 2019 specimens and provided a date of first use in commerce that did not in fact evidence such qualifying use, said specimens and allegations failed, and continue to fail, to evidence use in commerce of Applicant's mark and furthermore amounted to fraud committed on the U.S. Patent & Trademark Office.
- 30. Moreover, Applicant's application to register the mark **ZOXLIST** included a sworn declaration by Kara Kuipers, counsel for Applicant, to the U.S. Patent & Trademark Office in which Ms. Kuipers affirmatively stated that:

If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a): The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered; The mark is in use in commerce on or in connection with the goods/services in the application; The specimen(s) shows the mark as used on or in connection with the goods/services in the application; and The facts set forth in the application are true...[and] The signatory being warned

that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are

true and that all statements made on information and belief are believed to be true.

31. The U.S. Patent & Trademark Office relied upon Applicant's material false

statements and false specimen in approving the '432 Application for publication and would not

have otherwise done so but for Applicant's knowingly false statements and false specimen.

32. Applicant's acts as complained of herein constitute prosecution of a registration in

the U.S. Patent and Trademark Office for the **ZOXLIST** mark by a false or fraudulent

declaration or representation in writing in violation of 15 U.S.C. § 1120.

33. For the foregoing reasons, the '432 Application should be refused and denied.

WHEREFORE, for the foregoing reasons, Opposer respectfully requests that Application

Serial No. 88/582,432 for **ZOXLIST** be refused and denied registration.

Dated: October 13, 2020

New York, New York

Respectfully submitted,

LOMBARD & GELIEBTER LLP

/s/ Darren M. Geliebter

Darren M. Geliebter

Eric J. Huang

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New York, NY 10169

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(646) 349-5567 (facsimile)

Attorneys for Applicant John Zox

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Exhibit A

Int. Cls.: 9 and 41

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,838,652 Registered May 4, 2004

TRADEMARK SERVICE MARK PRINCIPAL REGISTER

ZOX

ZOX MUSIC (PARTNERSHIP) 44 BURNSIDE AVENUE RIVERSIDE, RI 02915

FOR: COMPACT DISCS FEATURING MUSICAL SOUND RECORDINGS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 12-30-1999; IN COMMERCE 5-30-2000.

FOR: ENTERTAINMENT, NAMELY, LIVE PERFORMANCES BY A MUSICAL BAND, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 11-28-1998; IN COMMERCE 1-29-1999.

SER. NO. 78-232,386, FILED 4-1-2003.

APRIL L. RADEMACHER, EXAMINING ATTORNEY

Int. Cls.: 9 and 41

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,965,344 Registered July 5, 2005

TRADEMARK SERVICE MARK PRINCIPAL REGISTER



ZOX MUSIC (RHODE ISLAND PARTNERSHIP) 44 BURNSIDE AVENUE RIVERSIDE, RI 02915

FOR: SERIES OF COMPACT DISCS FEATURING MUSICAL SOUND RECORDINGS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 12-30-1999; IN COMMERCE 5-30-2000.

FOR: ENTERTAINMENT, NAMELY, LIVE PERFORMANCES BY A MUSICAL BAND, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 11-28-1999; IN COMMERCE 11-28-1999.

OWNER OF U.S. REG. NO. 2,838,652.

THE COLOR(S) YELLOW AND BLACK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A CIRCULAR FACE WITH BLACK EYES, A BLACK MOUTH AND A HEADBAND.

SER. NO. 78-429,680, FILED 6-3-2004.

GIANCARLO CASTRO, EXAMINING ATTORNEY

United States of America United States Patent and Trademark Office

ZOX

Reg. No. 5,268,843

Andrew Zox (UNITED STATES INDIVIDUAL)

Registered Aug. 22, 2017

Church St. Sta. - PO Box 3236 New York, NY 100083236

Int. Cl.: 9, 41

Daniel Zox (UNITED STATES INDIVIDUAL)

Service Mark

Church St. Sta. - PO Box 3236 New York, NY 100083236

Trademark

John Zox (UNITED STATES INDIVIDUAL)

Church St. Sta. - PO Box 3236 New York, NY 100083236

Principal Register

CLASS 9: Prerecorded video cassette tapes, audio and video discs in the nature of CDs and DVDs and digital files, motion picture and documentary film, all featuring live action, computer generated, animated cartoons and musical entertainment and educational subject matter in the field of literature, science, history, art, government, engineering, philosophy, fashion, mathematics, economics, and zoology; film and video equipment, namely still, motion picture film and video cameras, videocassette recorders, videocassette players, digital video or audio players, and film and video editing machines; computer software for film and video editing; eyeglasses

FIRST USE 1-1-2006; IN COMMERCE 1-1-2006

CLASS 41: Production, development and distribution of motion picture films, television programs, documentary films, music videos, virtual and augmented reality videos, concert video and interactive media in the nature of literature, science, technology, religion, sports, politics, history, art, government, engineering, philosophy, fashion, mathematics, and economics; theatrical or musical works performed in a live setting; publication of books and screenplays; providing a website featuring educational information in the field of music, theater, cinema, design, photography, visual and performing arts and animal training; production of audio and audiovisual recordings; Entertainment in the nature of live radio personality performances; Entertainment services, namely, providing webcasts and video podcasts in the field of personality performances

FIRST USE 1-1-2006; IN COMMERCE 1-1-2006

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SEC.2(F)

SER. NO. 86-954,997, FILED 03-28-2016 SALLY SHIH, EXAMINING ATTORNEY



Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the

United States Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years* What and When to File:

- *First Filing Deadline:* You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods* What and When to File:

• You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*ATTENTION MADRID PROTOCOL REGISTRANTS: The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at h ttp://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

Page: 2 of 2 / RN # 5268843